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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837
29159	7590	12/13/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 12/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/654,025	<b>Applicant(s)</b> YOSELOFF ET AL.	
	<b>Examiner</b> Robert Mosser	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 15-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-24-2004</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**This action is non-final responsive to the RCE filed 8-24-2004.**

**Claims 11 and 15-26 are pending.**



***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24<sup>th</sup>, 2004 has been entered.

***Withdraw of Allowable Subject Matter***

The previously indicated allowable subject matter of papers mailed on 9/10/2003 and 2/24/2004 has been withdrawn upon further review. The following rejections address the previously indicated subject matter in light of the applicant's disclosure in the last paragraph of page ten of the specification starting "In the play of prior art reel-type games".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim **24** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically the support for the sequential treatment of symbols as a wild symbol appears to be lacking in the specification as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **21** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically claim **21** recites, "wild symbols are wild as to fewer than" which is unclear and has been interpreted as "wild symbols are fewer than" for the purposes of examination.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **11**, and **15-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US 6,439,993) in view of applicants admitted prior art.

With regards to claim **11**, O'Halloran teaches a method an apparatus for a video wagering game including:

a player placing a wager on a reel-slot-type video game event having a plurality of symbol positions(Abstract & Col 1:5-19);

displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position(Abstact, Col 1:5-19, & Figure 1);

upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions (Claim 18) as a wild symbol position (Col 2:60-67);

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converting (substitute) each symbol displayed within each selected wild symbol position to a wild symbol (Col 1:53-54); and

determining game outcomes based on the displayed game symbols and wild symbols in a single game event (Col 3:17-30).

O'Halloran is silent however regarding the inclusion of symbol positions bearing game symbols that produce scatter pays are excluded from the random selection of wild symbol positions. The applicant in the last paragraph of page 10 of the specification as originally filed presents this feature as a position sensitive wild symbol.

It would have been obvious to one of ordinary skill in the art at the time of invention to have included the inclusion of symbol positions bearing game symbols that produce scatter pays are excluded from the random selection of wild symbol positions in order to ensure that scatter pays were only available independent of the wild symbols.

With regards to claims 15, and in addition to the above stated, O'Halloran teaches "wild card symbols provides the player with an additional opportunity to win a prize, or to win an additional prize" (Col 3:1-3) which is held to encompass a "bonus feature" as claimed.

Claim limitations directed to the addressing of winning events (bonus outcomes) and in particular the resolving of winning events, is met by O'Halloran as the basic/traditional operation of a game of chance (Col 1:5-19).

Claim limitations directed to the occurrence of a “predetermined triggering event for a bonus event, randomly selecting at least one and fewer than all of said plurality of symbol positions as a wild symbol position” is met by the display of a trigger wild card symbol and the subsequent display of at least one further wild card symbol as taught by O’Halloran (Col 2:60-67).

Claim limitations directed to the converting symbol displayed within a wild symbol position to a wild symbol is met by the substitution of O’Halloran (Col 2:60-67).

With regards to claims **16-18**, and in addition to the above stated, O’Halloran teaches the resolution of winning events prior to the determination of the bonus outcome and after (about the same time) as the determination of the bonus outcome (Col 3:18-30).

With regards to claim **19**, and in addition to the above stated, O’Halloran teaches the inclusion of 15 viewable positions (Figure 1).

With regards to claim **20**, O’Halloran teaches the transformation of the wild symbol before the game outcome is determined (Col 2:64-67).

With regards to claims **21-23**, and **25-26**, O’halloran teaches that of  $N$  total symbols only  $N-1$  may be wild symbols Col 3:38-44 & Claims 18, 22, 25).

With regards to claim **24**, O’halloran is silent regarding the sequential treatment of each of the symbols displayed at each one of the designated locations as wild symbols however the sequential unveiling of a game out come is old and well known for drawing out the user’s anticipation during game play. It would have been obvious to

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one of ordinary skill in the art at the time of invention to have incorporated the sequential unveiling of a game outcome in the previously presented combination of O'Halloran and applicant's admitted prior art in order to draw out the player's anticipation of a game result.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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